REMARKS

Claims 1-8, 10-14, 16-22, 24-34, 36-51, 53-55, and 57-68 were rejected in an Office Action dated November 13, 2007. Claim 1 is amended; claim 7 is canceled. Support for the amendments may be found in the "Detailed Description of the Invention." Entry of the amendments is requested. Applicants respectfully request reconsideration of the present application in view of the following remarks.

Rejections under 35 USC §§102/103

Anticipated by or obvious over Hayes

Claims 1, 5, 10-14, 16, 17, 20, 21, 24-26, 32-34, 36, and 66-68 were rejected under 35 USC §102(b) as anticipated by or, in the alternative, under 35 USC §103(a) as obvious over Hayes (US 6,368,710 B1, hereinafter "Hayes"). Applicants respectfully traverse.

Applicants respectfully submit that the claims are not anticipated or obvious where none of elements of the moisture vapor transmission rate, the chemical permeation rate, and the sulfonic acid equivalent weight are disclosed or suggested by Hayes.

As acknowledged by the Examiner, the claim features relating to the sulfonic acid equivalent weight and permeation properties are not disclosed. Inherency principles have been applied by presuming the reference has properties within the claimed ranges when there is no disclosure or suggestion in support thereof. Applicants respectfully submit that the holding of *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980) has been improperly applied, and the burden was improperly shifted to Applicants to show that the claimed features relating to the sulfonic acid equivalent weight and permeation characteristics are not present in the prior art. However, under standard inherency principles, and as pointed out in previous Responses by Applicants, the burden is on the Examiner to show that an "allegedly inherent characteristic necessarily flows from the teachings of the applied prior art" (MPEP §2112.IV).

Applicants assert that *Fitzgerald* in this case is improper because the *Fitzgerald* court relied upon the applicability of product-by-process

principles to shift the burden to the applicant to show a difference. *See Fitzgerald*, 619 F.2d at 69-70. Under product-by-process principles, which are different from the inherency principles that place the burden of proof on the Examiner, the burden shifts to the applicant only "when it is established that the prior art discloses a product which reasonably appears to be either *identical* with or *only slightly different* than a product claimed in a product-by-process claim." *Id.* (emphasis added). Only after establishing by the appellants' own statement in that case that "[t]here is no other way to produce the patch-type fasteners defined in the appealed claims except by use of the specific process defined in [the parent application]" did the court apply product-by-process principles and shift the burden to the applicant. *Id.*

The present application is removed from the *Fitzgerald* rationale for at least three reasons, each of which will be addressed in the following:

- the pending claims are not amenable to product-by-process treatment because the claimed product may be produced by a variety of processes and there is no showing that there is an *identical* or *only slightly different* product in the cited references (*i.e.*, they are not analogous to the claims at issue in *Fitzgerald*);
- the pending claims are not amenable to product-by-process treatment because the product claims do not recite steps in a process (*i.e.*, they are not traditional product-by-process claims); and
- the claimed features recite particular property ranges that are not taught or suggested by the cited references.

As described in the multitude of examples provided in the present specification and as would be appreciated by those skilled in the art, the claimed products may be produced by a variety of methods and, therefore, differing characteristics may result depending upon the particular production method used. In addition, the wide variety of uses for the polymers disclosed by Hayes suggests that there are many different processes for the production of those polymers as well (see for example col. 11, lines 57). Clearly, the claimed products are not amenable to product-by-process treatment since the products cannot be said to be made by exclusively one process, as was the basis for the holding in *Fitzgerald*.

Without establishing this fundamental fact, the rationale of *Fitzgerald* cannot be relied upon by the Examiner to shift the burden of proof to Applicants. Accordingly, the burden still rests with the Examiner "to provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis added); MPEP §2112.IV.

Further, the claims are not otherwise amenable to treatment as product-by-process claims where they recite particular physical characteristics and not steps in a process. Accordingly, the Examiner likewise may not shift the burden to Applicants under traditional product-by-process principles.

Perhaps even more noteworthy, the burden cannot be shifted to Applicants to show that the cited references do not possess the claimed features because of the holding of *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993). The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *Id.* at 1534; MPEP § 2112.IV. In *Rijckaert*, the Federal Circuit reversed the USPTO's rejection because inherency was based on what would result due to optimization of conditions, and not what was necessarily present in the prior art. In other words, the lack of suggestion or disclosure of the specifically claimed property ranges precludes the application of inherency. "That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown." *Id.* (quoting *In re Spormann*, 363 F.2d 444, 448, 150 USPQ 449, 452 (CCPA 1966)).

Accordingly, in view of the wide variety of applications of the films disclosed by Hayes and their requisite wide variety of formulations and characteristics, there is no basis upon which to claim that Hayes would necessarily include a polymer having a sulfonic acid equivalent weight of about 400-800 and a permeation to bis-2-chloroethyl sulfide of less than or equal to 100 $\mu g/cm^2$ over a 20-hour period, as recited in claims 1 and 24, and a permeation to pinacolyl methylphosphono fluoridate of less than or equal to 30 $\mu g/cm^2$ over a 20-hour period, as recited in claim 66. Indeed, the *Rijckaert* holding forbids such a leap of logic.

Moreover, there is no basis upon which to state that Hayes would necessarily include a laminate comprising the claimed moisture vapor transmission rates as claimed in claims 1 and 8, which provide high levels of moisture transport while providing the claimed chemical penetration resistance. To the contrary, the materials of Hayes are recited as being suitable for applications such as a coating to provide a barrier to moisture (col. 8, line 59), or as a film to protect against the action of moisture (col. 10, line 14). Thus, it cannot be said that the allegedly inherent characteristic necessarily flows from the teaching of Hayes.

It is stated in the Office Action that materials of Hayes may be stretched to provide increased *resistance* to water vapor thus establishing the article is capable of transmitting moisture vapor. Applicants respectfully assert that that passage is not at col. 11, lines 13-27, as stated in the Office Action, and respectfully request clarification. Hayes does state that the properties exhibited by a film will depend on several factors including the polymeric composition, the method of forming the polymer, the method of forming the film, and whether the film was treated for stretch or biaxially oriented (col. 11, lines 40-49), which will affect properties such as shrinkage, tensile strength, elongation at break, impact strength, dielectric strength and constant, tensile modulus, chemical resistance, melting point, heat deflection temperature and the like.

There is no suggestion to modify the materials to get to the subject matter as claimed by Applicants, and no motivation provided to do so. No specific teaching is provided by Hayes and no objective evidence has been provided in the Office Action which would give rise to even a suggestion of the claimed products. The lack of suggestion or disclosure of the specifically claimed properties and ranges precludes the application of inherency. Where the Examiner has failed to provide objective evidence of each of the significant claimed elements, Applicants respectfully assert that rational used to arrive at the claimed invention is insufficient to establish that the claims are anticipated or obvious in view of Hayes.

For at least the foregoing reasons, Applicants respectfully submit that independent claims 1, 24, and 66 are patentable over Hayes. The

remaining dependent claims are patentable based on their dependency from claims 1, 24, and 66 and for the additional features recited therein.

Rejections under 35 USC §103

Unpatentable over Maples in view of Hayes

Claims 1-8, 10-14, 16, 17, 20-22, 24-34, 36-51, 53-55, and 57-68 were rejected under 35 USC §103(a) as being unpatentable over Maples (US 6,395,383, hereinafter "Maples") in view of Hayes. Applicants respectfully traverse the rejection for reasons as follows.

Applicants respectfully submit that the rational to combine the references is insufficient to establish a *prima facie* showing of obviousness since the combination does not disclose, teach, or suggest, as acknowledged by the Examiner, the claim features relating to the sulfonic acid equivalent weight and permeation properties. As discussed in greater detail below, the Examiner has improperly applied inherency principles by presuming the combination to have properties within the claimed ranges when there is no disclosure or suggestion in support thereof.

Again, for the reasons stated above, the holding of *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980) has been misapplied, and the Office has improperly shifted the burden to Applicants to show that the claimed features relating to the sulfonic acid equivalent weight and permeation characteristics are not present in the prior art. However, under standard inherency principles, and as pointed out previously, the burden is on the Office to show that an "allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." MPEP §2112.IV.

Moreover, as stated above, the Examiner cannot shift the burden to Applicants to show that the cited references do not possess the claimed features in view of the holding of *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993). The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *Id.* at 1534; MPEP §2112.IV. In *Rijckaert*, the Federal Circuit reversed the USPTO's rejection under obviousness because inherency was based on what would result due to optimization of conditions, and not what was

necessarily present in the prior art. Even if there were a proper reason to make the combination of Maples and Hayes (which Applicants submit there is not), the lack of suggestion or disclosure of the specifically claimed property ranges precludes the application of inherency. "That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown." *Id.* (quoting *In re Spormann*, 363 F.2d 444, 448, 150 USPQ 449, 452 (CCPA 1966)).

Accordingly, in view of the wide variety of applications of the films disclosed by Hayes, the wide variety of formulations, the additional factors in forming the polymers and films which results in different properties as stated above, there is no basis upon which to claim that a combination of Maples and Hayes would necessarily include a polymer having a sulfonic acid equivalent weight of about 400-800 and a permeation to bis-2-chloroethyl sulfide of less than or equal to 100 $\mu g/cm^2$ over a 20-hour period, as recited in claims 1, 24, 41, and 53, and a permeation to pinacolyl methylphosphono fluoridate of less than or equal to 30 $\mu g/cm^2$ over a 20-hour period, as recited in claim 66. Indeed, the *Rijckaert* holding forbids such a leap of logic.

Moreover, where Maples is directed to a protective covering having high moisture vapor transport (col. 4, line 4-33), and Hayes is directed to materials that protect against moisture and/or are used as barriers to moisture (col. 8, line 59, col. 10, line 14), one skilled in the art would reasonably assume that to combine a coating of Hayes to the protective barrier of Maples, would render Maples unsuitable for its intended purpose. Specifically, it is provided in Hayes at col. 13, lines 18-22, that polymeric sheets can be combined with other polymeric materials to form laminates with improved characteristics such as water vapor resistance. Thus, the references specifically teach away from the proposed combination.

For at least the foregoing reasons, Applicants respectfully submit that independent claims 1, 24, 41, 53, and 66 are patentable over Maples and Hayes, alone or in combination. Claims 2-8, 10-14, 16-22, 25-34, 36-40, 42-51, 54, 55, 57-65, 67, and 68 are patentable at least by virtue of their dependency from claims 1, 24, 41, 53, and 66 and for the additional features recited therein.

Unpatentable over Hayes, and further in view of Kershner et al.

Claims 18 and 19 were rejected under 35 USC §103(a) as being unpatentable over Hayes as applied to claim 1 above, and further in view of Kershner et al. (US 4,824,916, hereinafter "Kershner et al."). Where claims 18 and 19 are dependent upon claim 1 and contain all of the limitations of claim 1, Applicants respectfully assert that the claim is patentable for the reasons set foth above. Removal of the rejection is respectfully requested.

Conclusion

For the foregoing reasons, the present invention as defined by the claims is neither taught nor suggested by any of the references of record. Accordingly, Applicants respectfully submit that these claims are now in form for allowance. If further questions remain, Applicants request that the Examiner telephone Applicants' undersigned representative before issuing a further Office Action.

Respectfully submitted,

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